

Att'y Ref. No. 018-003

U.S. App. No.: 09/652,793

REMARKS

Favorable reconsideration, reexamination, and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks.

Telephonic Interview

Applicant and the undersigned wish to thank Mr. Chow for the courteous and productive interview conducted on 1 October 2004. Because Applicant was not relieved of the duty under 37 C.F.R. § 1.33(b) of providing a summary of the arguments presented during that interview, Applicant provides the following comments.

The substance of the telephonic interview conducted on 18 May 2004 was first discussed, and in particular the positive patentability statement on the Interview Summary therefor: "Applicants shall consider possible amendment in claim 3 for GPS . . .". The undersigned indicated that, in response to the Office Action, independent Claims 48, 68, 69, and 70 would be deleted, along with their dependent claims, in order to simplify the focus of this application. The undersigned and Mr. Chow then discussed the foregoing amendment to Claim 3, and its analog in Claim 65, and that this language corresponds to the subject matter discussed during the Interview of 18 May, without calling for GPS *per se*. Mr. Chow indicated that he would need to conduct a further search, to which the undersigned pointed out that: the 3 June 2004 Office Action was a ***fifth action non-final*** Office Action; subject matter similar to that presented in Claims 3 and 65 has been previously claimed, and acted on in several Office Actions; and that the subject matters of Claims 3 and 65 was viewed favorably in the 18 May 2004 Interview.

The undersigned also pointed out that the Applicant herein has already provided a Declaration and documentary evidence under 37 C.F.R. § 1.131 establishing a date of conception and reduction to practice prior to 28 February 1996, and therefore that some of the prior art relied upon in the Office Action is, in fact, not prior art to this application.

Rejection under 35 U.S.C. § 102

In the Office Action, beginning at page 2, Claims 48 and 68 were rejected under 35

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U.S.C. § 102, as reciting subject matters that allegedly are anticipated by U.S. Patent No. 5,550,551, issued to Alesio, and U.S. Patent No. 6,049,711, issued to Ben-Yehzekel et al ("Ben-Yehzekel"), respectively. Applicant respectfully requests reconsideration of this rejection.

By way of the foregoing amendments, Claims 48 and 68 have been cancelled. Accordingly, these rejections are now moot. Applicant expressly reserves the right to file one or more Divisional and/or Continuation applications to further pursue the subject matters of these claims, and does not acquiesce to the rejections thereof.

For at least the foregoing reasons, Applicant respectfully requests withdrawal of the rejections of Claims 48 and 68 under 35 U.S.C. § 102.

Rejection under 35 U.S.C. § 103(a)

In the Office Action, beginning at page 4, Claims 3, 4, 8-14, 16-23, 49-67, and 69-86 were rejected under 35 U.S.C. § 103(a), as reciting subject matters that allegedly are obvious, and therefore allegedly unpatentable, over various and numerous hypothetical combinations of the disclosures of: *Ben-Yehzekel*; U.S. Patent No. 5,561,704, issued to Salimando; U.S. Patent No. 5,930,729, issued to Khamis et al. ("Khamis"); U.S. Patent No. 5,438,695, issued to Morimura; U.S. Patent No. 5,802,492, issued to DeLorme et al. ("DeLorme"); *Alesio*; U.S. Patent No. 5,703,598, issued to Emmons; U.S. Patent No. 5,774,827, issued to Smith et al. ("Smith"); and U.S. Patent No. 5,365,451, issued to Wang et al. ("Wang"). Applicant respectfully requests reconsideration of this rejection.

Numerous aspects of the present application have been described throughout the lengthy prosecution of this application, and therefore Applicant will not further burden the record with redundant recitations. See, for example, the Amendment dated 26 March 2004, the Amendment dated 14 May 2003, and the Amendment dated 25 November 2002.

Claim 3 is directed to a mobile communications device having a combination of elements including, *inter alia*, a receiver configured to receive position signals from a satellite positioning system and means for sending present position information of the mobile communication device and the selection signal over a bi-directional wireless link.

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Claim 65 is directed to a method of receiving position-related information via a mobile communication device having a combination of steps including, *inter alia*, supplying a selection signal indicative of a topic of interest to the mobile communication device, receiving position signals from a satellite positioning system, and sending present position information of the mobile communication device and the selection signal over a bi-directional wireless link from the mobile communication device.

The prior art, including *Ben-Yehezkel*, *Salimando*, *Khamis*, *Morimura*, *DeLorme*, *Alesio*, *Emmons*, *Smith*, and *Wang*, fails to disclose, describe, or fairly suggest combinations of element or steps as recited in the combinations of the pending claims.

Applicant first notes that the subject matter of the present application was invented no later than 28 February 1996, more than eight-and-one-half years ago. Thus, it is important to review the patentability of the subject matters of the pending claims in light of the state of analogous technology and the level of skill of the routinier in the art as of early 1996, and not as of late 2004. Many advances have been made in the technology areas involved with the subject matters of the pending claims since the inventions herein were made, none of which should cast a negative light on the patentability of the pending claims. Indeed, the current advanced state of the art should not be the background against which the subject matters of the pending claims are viewed, but rather the relatively simple and sparse prior art background of early 1996.

While some or all of the aforementioned prior documents¹ have been discussed at length in other papers filed by Applicants in this application, a brief discussion of some of the documents may assist in a clearer appreciation of the allowability of the pending claims.

Ben-Yehezkel describes a Teletrac-based system. As described by *Ben-Yehezkel*, the Teletrac system is a ground-based, multi-base station system. According to *Ben-Yehezkel*, the system can provide some location information of a mobile unit, *e.g.*, one integrated into a vehicle, by triangulation based on the time required for the mobile unit to return signals using the Teletrac system to three of the Teletrac ground-based stations. Thereafter, a server-side system

¹ Applicant notes that several of the U.S. patent document relied upon in the Office Action are not prior art to this application, as demonstrated by the Declaration under 37 C.F.R. § 1.131 filed 26 November 2003.

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calculates the location of the mobile unit based on these return times, and forwards information to the mobile unit, again via the Teletrac system. Absent from *Ben-Yehzekel* is any identification or appreciation of any benefits from the use of a satellite positioning system, or for that matter of the use of such a satellite positioning system in conjunction with a bi-directional wireless link.

Salimando does not cure the deficiencies of *Ben-Yehzekel* with respect to the subject matters of the pending claims. *Salimando* merely describes a system whereby the user of a mobile unit, e.g., 'cell phone', can manually call an automated system, manually enter position coordinates (e.g., latitude and longitude) via the telephone to the system, and receive prerecorded information (e.g., location of a local automobile repair garage) based on the manually entered coordinates. Indeed, *Salimando* describes using his system from a typical land-line telephone, whereby the user manually enters a location of interest (not necessarily his/her actual location), thus emphasizing the manual aspects of *Salimando*'s system. Thus, while *Salimando* mentions GPS as a way that the user can obtain position coordinates, *Salimando* does not describe integrating such a GPS unit into a mobile communications unit, or a use of such a system, as recited in the combinations of the pending claims.

Alesio describes what is, in essence, a GPS-assisted vehicle location and tracking system, and also fails to make up for the deficiencies of *Ben-Yehzekel* and *Salimando*. According to *Alesio*, the vehicle-based system sends location information derived from a GPS receiver to a ground-based remote dispatch center; the ground-based center does not further communicate with the vehicle-based system. Instead, if the location coordinates of the vehicle have changed, or changed outside some acceptable range, as determined by the logic in the vehicle-based system, then the vehicle-based system transmits location information to the ground-based system so the vehicle can be tracked as it moves. Thus, while *Alesio* also mentions GPS as a way that the vehicle-based system can obtain position coordinates, *Alesio* does not describe the use of a bi-directional wireless link, or a selection signal, or a use of such a system, as recited in the combinations of the pending claims.

The other documents relied upon in the Office Action, to the extent that they are prior art at all to the present application, also fail to make up for the deficiencies of the prior art with

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respect to the subject matters of the pending claims. Stated somewhat differently, assuming *arguendo* that the hypothetical combinations alleged obvious in the Office Action were not the result of an impermissible hindsight reconstruction of the claimed subject matters from Applicant's own specification, the resulting theoretical construct would still not include each and every element or step recited in the combinations of the pending claims. Thus, the Office Action fails to make out a *prima facie* case, and the rejections should be withdrawn.

For at least the foregoing reasons, Applicant respectfully submits that the subject matters of Claims 3, 4, 8-14, 16-23, 49-67, and 69-86, each taken as a whole, would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention, are therefore not unpatentable under 35 U.S.C. § 103(a), and therefore respectfully requests withdrawal of the rejection thereof under 35 U.S.C. § 103(a).

New Claims

New Claims 87-110 have been added. All of Claims 87-110 depend from Claim 65, either directly or indirectly, and are therefore allowable for at least the same reasons. An indication of the allowability of Claims 87-110 is therefore respectfully requested.

Conclusion

Applicant respectfully submits that the present patent application is in condition for allowance. An early indication of the allowability of this patent application is therefore respectfully solicited.

If Mr. Chow or Mr. Urban believes that a telephone conference with the undersigned would expedite passage of this patent application to issue, his is invited to call on the number below.

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It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to our Deposit Account 50-2821.

Respectfully submitted,

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